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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/982,348 | 10/18/2001 | Edward J. McGunn | 272.00009 | 6707 |

7590 06/21/2004

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| EXAMINER | |
|---|---|
| BANGACHON, WILLIAM L | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2635 | 14 |

DATE MAILED: 06/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) |
|---|---|---|
| | 09/982,348 | MCGUNN ET AL. |
| | Examiner | Art Unit |
| | William Bangachon | 2635 |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *22 April 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-34* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-34* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/22/04 has been entered.

### *Response to Arguments*

2. Applicant's arguments with respect to claims 1-34 have been considered but are moot in view of the new ground(s) of rejection.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-3, 6-14, 18-21, 25-31, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,815,557 (Larson) in view of US 6,040,771 (Kim).

In claims 1, 6, and 27-28, Larson teach of a method of controlling a real estate lockbox (12) (analogous to the claimed safe) {see whole document}, said method comprising the steps of:

providing an electronic lock (12, 12', 56, 64) (i.e. door lock at an industrial site, a real estate lockbox, or any other kind of access control device {Larson, col. 2, lines 31-33}) for said lockbox/safe {col. 2, lines 28-34; col. 8, lines 57-65} through which a plurality of different types of transactions can be performed. In this case, the types of transaction performed are; a) the control unit (18) controls access to the lock (12), b) controls the time frame that a user can have access to the lock (12) {col. 2, lines 46-64}, and c) relays the identity of the user to the lock {col. 3, lines 23-26};

providing a control unit (18, 18', 54, 66) external to said safe and coupled to said electronic lock (12, 12', 56, 64) for monitoring said transactions between the control unit and the electronic lock {paragraph bridging cols. 3 and 4}, to allow a determination to be made through the control unit that a transaction has been performed {col. 3, lines 21-23; col. 4, lines 8-17}. Coupling is in the form of wireless communication;

receiving signals at said electronic lock from said control unit (as shown in figures 1-4); and

controlling said safe in response to said signals {col. 3, lines 23-31}.

Although Larson teaches the lock may be a door lock at an industrial site, a real estate lockbox, or any other kind of access control device {Larson, col. 2, lines 31-33}, Larson does not disclose expressly "an electronic lock for a **safe**". And although the lockbox of Larson is analogous to a safe for small items such as keys, Larson does not disclose expressly that the lockbox is a safe. In this case, Kim in the same field of endeavor (lock systems), is relied upon to teach of a safe (10) with a housing (12) and

electronic lockable door (14) as shown in figure 1 {Kim, col. 3, lines 18-27}, for the purpose of providing a safe which recognizes when an attempt to move, damage, destroy, or any problematic outer force is caused to the safe by an unwanted intruder {Kim, col. 3, lines 11-17}. Clearly, the safe of Kim is desirable in the delivery truck of Larson {Larson, col. 8, lines 56-60}, because Larson is concerned with guarding against unauthorized opening of the delivery truck {Larson, col. 8, lines 60-65}. And obviously, the lock of Larson is operable in the safe of Kim. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to have a **safe** with an electronic lockable door in the system of Larson, as evidenced by Kim, because the safe of Kim can recognize an attempt to circumvent the security of the delivery truck of Larson. The suggestion/motivation for doing so would have been because the safe of Kim recognizes when an attempt to move, damage, destroy, or any problematic outer force is caused to the safe by an unwanted intruder and therefore guard against unauthorized opening of the delivery truck. Therefore, it would have been obvious to combine the electronic lock of Larson with the safe of Kim to obtain the invention as specified in claim 1.

Larson does not disclose expressly "a control unit monitoring said transactions with said electronic lock". In this case, Larson teaches that the control unit (18) controls access to the lock (12) and also controls the time frame that a user can have access to the lock (12) {col. 2, lines 46-64}. The control unit (18) has knowledge of all accesses that it has authorized {col. 3, lines 15-18}. Obviously, this is analogous to having the

control unit monitoring all transactions with the lock, to one of ordinary skill in the art. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to have "the control unit (18) monitoring all transactions with said electronic lock (12)" as claimed, because the control unit has knowledge of all accesses to the lock that it has authorized.

Larson does not disclose expressly "causing the electronic lock to be operated to open the door without requiring intervention by a user of the safe at the safe". In this case, Larson teach "the clearinghouse relays to the lock that a user is coming, the identity of the user, and the time period during which the user is to be able to access the lock. And that by this arrangement, the lock needn't be programmed with a list of authorized users." {col. 3, lines 23-32}. Obviously, in this arrangement, the user can operate the lock without intervening with the lock, as long as the user gets to the lock at the prescribed time.

In claim 2, the method of claim I further comprising a step of sending an unlock signal to said electronic lock from said control unit {paragraph bridging cols. 3 and 4; col. 4, lines 18-29}.

In claim 3, the method of claim 2 wherein said step of sending an unlock signal comprises sending an unlock signal after receiving a lock number (analogous to the claimed user ID) and a PIN {col. 2, lines 34-56}.

In claim 7, the method of claim I further comprising a step of sending signals from said electronic lock to said control unit {paragraph bridging cols. 4 and 5}.

Claim 8 recites the combination of claims 1 and 2 and therefore rejected for the same reasons, further comprising the step of:

receiving login information at a control unit external to said safe {col. 2, lines 35-46; col. 3, lines 52-65};

In claim 9, the method of claim 8 further comprising a step of saving said login information in a database {col. 3, lines 23-31}.

In claims 10-13, the method of claim 8 wherein said step of enabling a user to select an open door option comprises enabling entry of an override response key (46) {col. 6, lines 62-67}.

Claim 14 recites the claim limitations of claim 3 and therefore rejected for the same reasons.

Claims 18-19 recites the limitations of claim 8 and therefore rejected for the same reasons.

Claim 20 recites the limitations of claim 3 and therefore rejected for the same reasons.

Claim 21 recites the limitations of claim 9 and therefore rejected for the same reasons.

Claim 25 recites the combination of claims 6 and 18 and therefore rejected for the same reasons.

In claim 26, the method of claim 18 further comprising a step of providing a status of said electronic lock to said control unit {paragraph bridging cols. 4 and 5}.

Claims 27-34 recites an apparatus used for practicing the method of claims 1-7 and therefore rejected for the same reasons.

7. Claims 4-5, 15-17, and 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,815,557 (Larson) in view of US 6,040,771 (Kim), and further in view US 5,349,345 (Vanderschel).

In claims 4 and 15, Larson does not disclose the step of encrypting said PIN. However, Vanderschel, in the same field of endeavor (electronic locks), teach of encrypting an access PIN as shown in the table of column 4 {Vanderschel, col. 4, lines

14-41}, for security reasons. Vanderschel suggests that it is desirable to encrypt access PIN's to make it safe from unauthorized inspection {col. 5, lines 21-26}. Clearly, this feature is desirable in the system of Larson. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to encrypt the access PIN of Larson, as evidenced by Vanderschel, because this makes it safe from unauthorized inspection.

In claims 5, 16-17, the method of claim 3 further comprising a step of saving at least a portion of said signals in an audit database {col. 3, lines 23-31}.

Claims 32-33 recites an apparatus used in practicing the method of claim 5 and therefore rejected for the same reasons.

***Examiner Contact Information***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William L Bangachon whose telephone number is 703-305-2701. The examiner can normally be reached on 4/4/9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on 703-305-4704. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

William L Bangachon
Examiner
Art Unit 2635

June 16, 2004

MICHAEL HORABIK
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600